



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,571	07/21/2003	Masaru Iriya	0071-0528P	4799

2292 7590 08/24/2005

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/622,571

**Applicant(s)**

IRIYA ET AL.

**Examiner**

Michael C. Miggins

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the appeal brief filed on 6/10/05, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Delaney (US 2083007).

Delaney disclose an electronic unit (page 1, column 1, lines 7-28) comprising a housing (page 1, column 1, lines 1-6), at least two electronic elements contained within

Art Unit: 1772

said housing (page 1, column 1, lines 1-6), a potting compound surrounding said electronic elements (page 1, column 1, lines 1-6) comprising first composition which when used alone applies a given force to elements encased within (the halogenated naphthalene/bitumen exerts a shrinkage force on the elements encased, see page 1, column 1, line 28 through page 1, column 2, line 3), and a second composition which attenuates said force when subjected to thermal cycling (the natural wax corrects shrinkage during heating, see page 1, column 1, line 28 through page 1, column 2, line 3) (applies to instant claims 1 and 5).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delaney (US 2083007) in view of Calhoun (US 5726386).

Delaney discloses a potting compound comprising asphalt (page 1, column 1, lines 5-15).

The difference between the instant claims and Delaney is that Delaney fails to disclose the potting compound comprising a mixture of asphalt and sand.

Calhoun discloses a potting compound comprising a mixture of asphalt and sand (column 5, lines 1-15) for potting electrical components for the purpose of providing

Art Unit: 1772

improved flow rates and higher electrical power, and allows precise control of the amount and temperature of the potting compound (applies to instant claims 2 and 6).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a mixture of asphalt and sand in the potting compound of Delaney in order to provide improved flow rates and higher electrical power, and allows precise control of the amount and temperature of the potting compound as taught or suggested by Calhoun.

6. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delaney (US 2083007) in view of Earing (US 4022635).

The difference between the instant claims and Delaney is that Delaney fail to disclose a potting compound comprising a solvent refined paraffinic petroleum oil, wherein said paraffinic petroleum oil comprises about 0.1 to 20 wt% of said compound.

Earing discloses a potting compound comprising a solvent refined paraffinic petroleum oil, wherein said paraffinic petroleum oil comprises about 0.1 to 20 wt% of said compound (column 4, lines 30-64) for the purpose of providing improved physical properties to the potting compound (applies to instant claims 3-4 and 7-8).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a solvent refined paraffinic petroleum oil, wherein said paraffinic petroleum oil comprises about 0.1 to 20 wt% of said compound in the potting compound of Delaney in order to provide improved physical properties to the potting compound as taught or suggested by Earing.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCM *McM*  
August 19, 2005

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

*1772*

*8/22/05*